

**REMARKS**

Claims 1, 2, 6, 7, 10-18 and 21 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,108,785 granted to *Poisner* ("Poisner"). This rejection is respectfully traversed for the reasons set forth below.

Amended independent claims 1 and 21 now include: "A system comprising: a multipurpose authorized user identification device providing physical access to a premisses and access to a computer system on the premisses; at least one processor coupled to the computer system; a first Bluetooth device provided on the identification device providing a communication capability with a second Bluetooth device provided in the computer system including a non-line-of-sight proximity range actuated identification signal detection circuit for receiving a wireless identification signal from the identification device, the wireless identification signal containing identification information regarding one or more users of the device; ..."

The PTO provides in MPEP § 2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Poisner* patent must contain all of the claimed elements of independent claims 1 and 21. However, the claimed combination is not shown or taught by the *Poisner* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

For these reasons, the rejection of independent claims 1 and 21, as now amended, should be withdrawn. Applicant submits that independent claims 1 and 21, along with the claims dependent therefrom, are allowable over *Poisner*.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,108,785 granted to *Poisner* and further in view of U.S. Patent 5,960,085 granted to *de la Huerga* ("*de la Huerga*"). This rejection is respectfully traversed for the reasons set forth below.

Claim 5 depends from claim 1. Independent claim 1 includes: "A system comprising: a multipurpose authorized user identification device providing physical access to a premises and access to a computer system on the premises; at least one processor coupled to the computer system; a first Bluetooth device provided on the identification device providing a communication capability with a second Bluetooth device provided in the computer system including a non-line-of-sight proximity range actuated identification signal detection circuit for receiving a wireless identification signal from the identification device, the wireless identification signal containing identification information regarding one or more users of the device; ..."

35 U.S.C. §103(a) provides that:

*[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the *Poisner* patent alone, or in combination with *de la Huerga*, do not teach the program identifying an operating system manufacturer and version and determining if the version is older than a current required version.

Therefore, it is impossible to render the subject matter of claim as a whole obvious based on the *Poisner* patent considered alone or in combination with the *de la Huerga* patent, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 5, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the *Poisner* and *de la Huerga* patents cannot be combined and applied to reject claim 5 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

*[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must*

*be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*

Here, *Poisner* and *de la Huerga* do not teach, or even suggest, the desirability of the combination because neither teaches or suggests providing the program identifying an operating system manufacturer and version and determining if the version is older than a current required version.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 5.

In this context, the MPEP further provides at §2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 5. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 5, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1 and 21 and the claims dependent therefrom are submitted to be allowable.

Because all the limitations of claims 1 and 21 have not been met by the *Poisner* and *de la Huerga* patents, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

In view of the above, it is respectfully submitted that remaining claims 1, 2, 5-7, 10-18 and 21 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

  
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